

REMARKS

In the Office Action of September 22, 2004, claims 1-19 and 25-27 were rejected under 35 U.S.C. §101 as drawn to non-statutory subject matter, claims 1, 19, 20 and 25 were rejected under 35 U.S.C. §112 as incomplete and claims 1, 2, 6, 7, 9-11, 13, 16-18, 20, 21 and 24-27 were rejected under 35 U.S.C. §102(a) as anticipated by International Publication WO 99/66428 of Zucker published on December 23, 1999. Claims 12, 14-15, 22 and 23 were rejected under 35 U.S.C. §103(a) as obvious over WO 99/66428. Claims 3-5 and 8 were rejected under 35 U.S.C. §103(a) as unpatentable over Zucker in view of U.S. patent publication 2001/0011247 to O'Flaherty; and claim 19 was rejected under 35 U.S.C. §103(a) as unpatentable over Zucker in view of U.S. Patent No. 5,903,652 to Mital.

With respect to the rejection of claims 1-19 and 25-27 as directed to non-statutory subject matter, applicants respectfully disagree with the Examiner's interpretation of the law. The claims do more than manipulate an abstract idea. They are directed to the protection of a user's privacy when purchasing goods over a communications network. They specify particular steps to be performed to accomplish that goal; and if the steps are followed they accomplish the extremely useful result of protecting the user from invasions of privacy by the merchant from whom the goods are purchased. Anyone who has been plagued by unwanted e-mail, which probably includes just about everyone with an e-mail account, will appreciate the value of avoiding unwanted e-mail. Applicants' invention thus provides a concrete, tangible and useful result – the protection of the user's privacy from unwanted intrusions by a merchant from whom he or she purchases goods over a communication network.

The Examiner's citation of AT&T v. Excel Communications Inc., 172 F.3d 1352 (Fed. Cir. 1999) overlooks a similar case, State Street Bank & Trust Co. v. Signature Financial Group, Inc., 149 F.3d 1368 (Fed. Cir. 1998), which likewise requires that the invention produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373. In State Street, the result was the calculation of a final share price. In the present invention, the merchant is provided sufficient information for a user to make a purchase without providing the user's identity or complete address and the shipper is provided the information needed to deliver the goods. This information is every bit as useful, concrete

and tangible as the final share price generated by the hub-and-spoke system at issue in State Street. Accordingly, applicants request that the rejection of claims 1-19 and 25-27 be withdrawn.

Reconsideration is also respectfully requested for the rejection of claims 1, 19, 20 and 25 under 35 U.S.C. 112, second paragraph, for omitting step of how the decryption information is supplied to the shipper which the Examiner believes to be essential. What is essential in this step is that the decryption information not be provided to or by the merchant. But it is also clear from the claim language that the decryption information is not provided to or by the merchant because that would give the merchant the information needed to decrypt the encrypted address and thereby defeat the whole purpose of the invention. Since the essential limitations on this step are apparent from the stated purpose of these claims, it is believed that claims 1, 19, 20 and 25 do not lack an essential step. For the Examiner's information, it is also noted that the specification makes clear at page 8, lines 31 and 32 that in the preferred embodiment of the invention decryption information is supplied to the shipper by the trusted entity maintaining secure server 108.

With respect to the rejection of the claims on 35 U.S.C. 102 and 103, applicants note that the effective date of the Zucker reference WO 99/66428 is the publication date of December 23, 1999. As the Examiner acknowledges, the present application claims the benefit of provisional application 60/174,638 filed January 5, 2000. Fig. 1 of the provisional application is substantially the same as Fig. 2 of the present application except for use of different element numbers. At page 2, line 15, the present application also incorporates by reference application no. 09/360,812 filed on July 26, 1999. At page 2, lines 6-8 the provisional application also incorporates by reference Application Serial No. 09/360,812. A continuation of the '812 application is application no. 10/441,844 which was published as patent publication US2004/0002903A1 on January 1, 2004. A copy of the '903 application is enclosed. The present application and the '903 application are commonly assigned and share a common inventor, Salvatore Stolfo.

Figures 4 and 4A-4Q of the '903 application illustrate the details of a private purchasing and shipping system. The same figures are found in the '812 application filed July 26, 1999.

Every feature of the Zucker reference that is relied on by the Examiner in paragraph 13 of the Office Action in rejecting claims 1, 20 and 25 of the present application is anticipated in essential part by the '812 application as is apparent from the following chart:

Zucker	'812 Application
A. Providing a proxy identity Fig. 12, 9:1-9 (FREDSTONE 01234)	"User proxy software 114a is registered to Customer C under proxy identifier I." ¶0185, lines 5-6. (PROXY I)
B. Receiving a shipping address *Fig. 12, 8:18-28 (123 Park Place)	"A final shipping address designated by the first party and the shopping session number is stored in the secured address mapping (SAM) database 119 (FIG. 3B)." ¶0188, lines 1-3 (ADDRESS G)
C. Partially encrypting the shipping address Fig. 13, 10:15-24, 23:20-24:8 (1 Main Street)	"The proxy (depot) delivery address A is linked to the user's delivery address G in the secured address mapping (SAM) database 119 (FIG. 3B)." ¶0191, lines 13-16. (PROXY ADDRESS A)
D. Transmitting the proxy identity and encrypted shipping address to a merchant (10:15-24; 23:20-24:8) "The buyer 120 would identify themselves with their pseudopayment information . . . financial institution server 142 converts the pseudopayment information . . . and returns it to the seller client 112 with an encrypted delivery address of the buyer."	"If authorization is provided, the bank...adds the following (FIG. 4J) to the previously generated order information. . . : the proxy system operator's proxy identifier P, . . . the proxy system-operator's depot shipping address for delivery A." ¶0191 lines 1-9.
E. Providing decryption information to a shipper 10:15-24; 23:20-24:8 "The package is picked up by the freight company 150, the address is decrypted . . ."	"The retailer then ships the good in step 14 to the proxy system operator's shipping depot address A with labeling containing the proxy system operator's proxy identifier P and the session identifier #F. ¶0193, lines 8-12. "The proxy computer 108 in step 16 (FIG. 4O) directs the depot A (a) to ship the

	continued. goods to customer address G designated by the first user to the proxy system . . . “¶0194, lines 1-3.
F. Whereupon shipper can generate a label with the true shipping address 10:15-24; 23:20-24:8	“The proxy computer 108 in step 16 (FIG. 4O) directs the depot A (a) to ship the goods to customer address G designated by the first user to the proxy system . . . “¶0194, lines 1-3.

The table of Figure 8 of the '812 application summarizes who knows what about the customer. As indicated in the table, the retailer does not learn the customer's actual address, his name, his credit card number or his PIN number.

Similarly, with respect to the dependent claims discussed in paragraphs 14-21 of the Office Action, the '812 application discloses the use of:

- a proxy credit card account D (¶0186, line 8);
- a single use identifier P#F (¶0191, lines 9-12);
- the Internet as the communications network (¶0002, lines 1, 9 and 10);
- shipping address A that is close enough to the customer to permit customer pick-up as an option (¶0194, lines 4 and 5) and therefore is reasonably likely to be with the same taxing jurisdictions;
- maintenance of transactions records for future use (FIGS. 5, 6 and 7; ¶0195);
- returns (¶0175, line 9);
- a unique shopping session identifiers #F (¶0187, lines 21-24); and
- a proxy delivery address A linked to the user's delivery address G in the secured address mapping (SAM) database 119 of FIG. 3P (¶0191, lines 13-16);

With respect to the rejection of claim 17, the retailer ships the goods to the proxy system operator's shipping depot address A with labeling containing the proxy system operator's proxy identifier P and the session identifier #F. (¶ 0193, lines 8-12).

With respect to the rejection of claim 18, it is respectfully submitted that Zucker does not make it clear what he means by privacy preferences. There is no basis for the Examiner's assertions that such preferences relate to privacy level selections.

With respect to the rejections of claims 12, 14, 15, 22 and 23 under 35 U.S.C. 103, the '812 application discloses the use of

an IP Address A' (Fig. 4); and

a shipping address A distinct from the user's actual address G.

As the Examiner concedes Zucker does not disclose encrypting the shipping address.

With respect to the rejection of claim 19, the '812 application contemplates at paragraph 0194 that the shipped goods might be held for pick-up.

A pick-up number J (¶0193, lines 12-19) which is the pick up number generated by the shipping depot would appear to have a function similar to a Post Office Box number.

With respect to the rejections of claims 3-5 and 8, the Examiner acknowledges that Zucker does not disclose the use of a physical integrated circuit card or a digital wallet in the step of issuing a proxy identity.

Because the '812 application, which is incorporated by reference in the present application and has a filing date prior to the Zucker reference, discloses the features of the Zucker on which the Examiner relies for rejecting applicants' claims, it is submitted that Zucker is not available as a reference against the present applications. Since Zucker is relied as for all the Examiner's rejections under 35 U.S.C. 102 and 103, the rejections are believed to be overcome.

As new claim 28 has been added which is believed patentable for the same reason claim 1 is patentable.

In view of the forgoing remarks, the claims in this application are believe to be in condition for allowance. Such action is respectfully requested. If the Examiner believes a telephone interview would expedite prosecution of this application, he is invited to call applicants' attorney at the number given below. No additional fee is believed due for filing this response. However, if a fee is due, please charge such fee to Morgan, Lewis & Bockius LLP Deposit Account No. 50-0310.

Respectfully submitted,

Date: January 24, 2005


Francis E. Morris (Reg. No.) 24,615
MORGAN, LEWIS & BOCKIUS LLP
101 Park Avenue
New York, NY 10178
(212) 309-6632